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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,169	11/13/2003	Bruce D. Williams	13-97	9814

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,169

Applicant(s)

WILLIAMS ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-24 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the provisional election mailed July 3, 2006.

Claims 11-12 were amended rendering claims 11-24 pending.

Claim Rejections – 35 USC 112, first paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

Claim Rejections – 35 USC 112, second paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In instant claim 11, it is unclear how much starch content is in the non-currency grade paper.

Claim Rejections – 35 USC § 102(b)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-16 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871).

Collings discloses verifying the authenticity of a coupon or paper by incorporating a chemical reagent in the paper which on being contacted by an authenticating composition will produce a characteristic colour change (column 1, lines 13-26 and 51-61) where starch is incorporated and the authenticating composition is an acidic

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solution, where the reaction creates a dark colouration (column 2, lines 31-44). Collings additionally discloses the starch may be applied by a coating or printing technique, where the printing may be in the form of a pattern (column 4, lines 61-68). The verification of the authenticity of the paper can be done using pens (column 5, lines 7-16) which would result in only a portion that is marked with the pen to be reacted. Because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

Claim Rejections – 35 USC § 102(b)

8. Claims 11-14 and 16, 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887).

Ahlm, Jr. discloses verifying the authenticity of a coupon having a surface printed with an indistinguishable material which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65). The Figure of Ahlm, Jr. shows a large portion of the coupon avoiding a reaction with the chemical and not undergoing a color change for the authentic coupon and another portion undergoing the reaction to produce a color change to a darker color than the paper. Because Ahlm, Jr. is silent of starch, ~~it is a good~~ ^{one of ordinary skill in the art could} ascertain that the coupon is free of starch, rendering it ^{not} ~~a~~ to have a lower starch content than non-currency grade paper.

Claim Rejections – 35 USC § 103(a)

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) in view Kurrle (U.S. 6,214,766).

Collings is relied upon for instant claims 11, 20 and 21. Collings does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Collings and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied the coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Collings to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

Claim Rejections – 35 USC § 103(a)

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766).

Ahlm, Jr. is relied upon for instant claims 11, 20 and 21. Ahlm, Jr. does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Ahlm, Jr. and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Ahlm, Jr. to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

12. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited method further including determining that the coupon is authentic when a light mark results from applying a chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Response to Arguments

13. Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871) has been considered but is unpersuasive. Applicant argues because Collings teaches adding starch to the first material, the first material in Collings does not inherently possess less starch content than non-currency paper as recited in claim 11. Because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed. Applicant further argues Collings does not teach using a currency counterfeit detection pen as the chemical applied to detect authenticity. The Examiner is not persuaded by this argument because Collings discloses the verification of the authenticity of the paper can be done using pens (column 5, lines 7-16)) which would result in only a portion that is marked with the pen to be reacted. Applicant argues the starch content in Collings is a trace chemical residual. Applicant's limitation in claim 11 of "a first material having a lower starch content than non-currency grade paper" is interpreted to mean the first material is capable of having a certain amount of starch. Additionally, because the method of verifying the authenticity of a coupon of the instant invention is disclosed as comprising the various materials and processes, the starch material found in the Collings reference, is not excluded from the disclosure of the instantly claimed invention. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude

additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Applicant argues claim 21 is not anticipated because Collings teaches adding a first material that contains starch. Collings discloses incorporating starch in the paper in column 2, lines 30-44, and does not disclose coating the coupon with starch, therefore, meeting the limitation of instant claim 21.

Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887) has been considered but is unpersuasive. Applicant argues because Ahlm, Jr. does not disclose the use of starch or iodine for marking and authenticating papers or coupons, Ahlm, Jr. does not have an inherently lower starch content than non-currency grade paper. Because Ahlm, Jr. is silent of starch, it is a good assertion that the coupon is free of starch, rendering it to have a lower starch content than non-currency grade paper. Applicant argues Ahlm, Jr. relies on the presence of a reaction, so it does not meet the limitation of claim 16. The Figure of Ahlm, Jr. shows a large portion of the coupon avoiding a reaction with the chemical and not undergoing a color change for the authentic coupon and another portion undergoing the reaction to produce a color change to a darker color. Applicant argues the colloidal silica content in Ahlm, Jr. is a trace chemical residual. Because the method of verifying the authenticity of a coupon of the instant invention is disclosed as comprising the various materials and processes, the colloidal silica found in the Ahlm, Jr. reference, is not excluded from the disclosure of the instantly claimed invention. The transitional term "comprising", which is synonymous with "including," "containing," or

"characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Applicant argues claim 21 is not anticipated because Ahlm, Jr. does not mention starch. Because Ahlm, Jr. is silent of starch, it is a good assertion that the coupon is substantially free of starch.

Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) has been considered but is unpersuasive. Applicant argues both Collings and Kurrle deal with authenticating paper via the use of starch and claim 24 recites using flexography to apply material that substantially lacks any starch. Claim 24 claims coating the printed coupon with a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process.

Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) has been considered but is unpersuasive. Applicant argues both Ahlm, Jr. and Kurrle deal with authenticating paper via the use of starch and claim 24 recites using flexography to apply material that substantially lacks any starch. Claim 24 claims coating the printed coupon with a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution

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added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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